

App. No. 09/966,677
Amdt. Dated 03/24/2004
Reply to Office Action of 10/24/2003

REMARKS

This is in response to the Final Office Action mailed on 11/19/2003. In the Final Office Action claims 1-27 were rejected under 35 U.S.C. § 103(a). Reexamination and reconsideration in view of the amendments and the remarks made herein is respectfully requested

Applicant has amended claims 1, 6, 8-9, 11, 15-19, and 22-27 by this response. Applicant has added new dependent claim 33. Applicant has cancelled claims 5 and 12 without prejudice. Claims 28-32 were previously cancelled. Accordingly, claims 1-4, 6-11, 13-27, and 33 are now pending. Of the pending claims, claims 1, 11, 19, 22, and 25 are independent claims.

Applicant believes that no new matter has been added by this response.

I) Claim Rejections Under 35 U.S.C. § 103(a)

In section 3 of the Final Office Action, claims 1-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,566,327 issued to Richard P. Sehr ("Sehr") in view of U.S. Patent No. 6,484,947 issued to Tsuneo Miyata. ("Miyata"). [Office Action, pages 2-7]. Applicant respectfully traverses this rejection.

Applicant has amended independent claims 1, 11, 19, 22, and 25 to clarify the claimed invention.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

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success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)" [MPEP § 2142; 8th Edition, Rev. 1, Feb. 2003, Pg. 2100-124].

The Office Action alleges that "Sher discloses a computerized theme park [5] information management system using either contact type or non-contact type smart cards and a method of keeping an accurate record of monetary transactions." [OA, page 2, lines 16-18]. Applicant respectfully disagrees.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." [MPEP §2141.02, 8th Edition, Rev. 1, Feb. 2003, Pg. 2100-122; citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)].

Applicant respectfully submits that Sher does not disclose using non-contact type smart cards or readers. Sher does not disclose any antenna for wireless or radio frequency identification (RFID). Sher's Figure 1 illustrates a smart card reader 11 with a slot to make contact with a smart card. Sher's Figure 2 illustrates an admission center with a "slot [that] is used for reloading or transfer of payment and theme park related privileges into these cards." [Sher, Col. 5, lines 28-29]. "Slot 46 is used to store security data into the guest card should the visitor decide to do so." [Sher, Col. 5, lines 38-40].

Specifically with regards to independent claim 1, Sher does not disclose "reading a **radio frequency identification (RFID)**

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tag worn by said guest to obtain a tag identifier". (Emphasis Added) [Claim 1 as amended, lines 5-7]. Regarding independent claim 11, Sher does not disclose "a **radio frequency identification (RFID) reader to read a tag identifier stored in a **radio frequency identification (RFID) tag** worn by a guest at said coverage area". (Emphasis Added) [Claim 11 as amended, lines 4-7]. Regarding independent claim 19, Sher does not disclose a "processor to receive a tag identifier pertaining to a **radio frequency identification (RFID) tag** worn by a guest of said coverage area by way of said service terminal or kiosk system". (Emphasis Added) [Claim 19, lines 11-15]. Regarding independent claims 22 and 25, Sher does not disclose "a second data field [for] containing a tag identifier pertaining to a **radio frequency identification (RFID) tag** worn by a guest of said coverage area". (Emphasis Added) [Claim 22, lines 7-9; claim 25, lines 8-11].**

The Office Action states that Miyata discloses a portable non-contact type personal identification system that can be combined with Sher. However, Sher teaches away from using non-contact type smart cards and requires the use of contact type smart cards. Sher's "access modules 400 and 401 control the entrance and exit of visitors. The visitors need to insert their guest card into these modules when entering or exiting the theme park. This methodology prevents the transfer and usage of one guest card by more than one visitor." [Sher, Col. 5, lines 43-47].

In order to combine Miyata and Sher together, Sher's contact smart card readers would need to be substantially reconstructed as non-contact readers - changing the basic method under which Sher's smart cards and readers were designed to communicate.

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"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." [MPEP 2143.01, 8th Ed., Rev. 1, Feb. 2003, Pg. 2100-127 citing *In re Ratti*, 270 F2d. 810, 123 USPQ 349 (C.C.P.A. 1959)]. It is not a proper ground of rejection when the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." [MPEP 2143.01, 8th Ed., Rev. 1, Feb. 2003, Pg. 2100-127 citing *In re Ratti*, 270 F2d. 810 at 813, 123 USPQ 349 at 352 (C.C.P.A. 1959)].

Furthermore as was discussed previously, Sher's access modules 400 and 401 require guest card insertion to "prevent[] the transfer and usage of one guest card by more than one visitor." [Sher, Col. 5, lines 46-47]. By using Miyata's non-contact tag and non-contact readers in Sher, Sher would no longer require guest card insertion and could not prevent the transfer and usage of one guest card by more than one visitor, vitiating Sher's access control.

"If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." [MPEP § 2143.01, 8th Edition, Rev. 1, Feb. 2003, Pg. 2100-127; citing *In re Gordon*, 733 F2d. 900, 221 USPQ 1125 (Fed. Cir. 1984)].

Furthermore, Applicant respectfully submits that the motivation provided by the Office Action for combining/modifying Sher with Miyata, "providing convenience to the data storage medium and reducing the possibility of losing the device", and

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"an obvious matter of design variation, well within the ordinary skill in the art, and therefore an obvious expedient", are not convincing. [Office Action, page 3, lines 20-22, and page 4, lines 1-2].

"[T]he examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." [MPEP § 706.2(j), Original 8th Edition, Aug. 2001, Pg. 700-31; citing *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App & Inter. 1985)].

For the foregoing reasons, Applicant respectfully submits that independent claims 1, 11, 19, 22, and 25 are not made obvious by the combination of Sher and Miyata.

Regarding the rejected dependent claims, rejected claims 2-4 and 7-10 depend directly or indirectly from independent claim 1. Rejected claims 13-18 depend directly from independent claim 11. Rejected claims 20-21 depend directly from independent claim 19. Rejected claims 23-24 depend directly or indirectly from independent claim 22. Rejected claims 26-27 depend directly from independent claim 25.

Applicant has cancelled claims 5 and 12 so the rejection of these dependent claims is now believed to be moot.

Applicant believes that it has placed independent claims 1, 11, 19, 22, and 25 in condition for allowance such that dependent claims depending there from with further limitations are also in condition for allowance. Thus, Applicant respectfully submits that dependent claims 2-4, 7-10, 13-18, 20-21, 23-24, and 26-27 are also in condition for allowance.

Accordingly for the foregoing reasons, Applicant respectfully requests the withdrawal of the 35 USC 103(a) claim rejections of claims 1-27.

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II) New Claims

Applicant has added new dependent claim 33.

New claim 33 depends from independent claim 1

Applicant believes it has placed independent claim 1 in condition for allowance such that dependent claims depending there from with further limitations are also in condition for allowance.

Applicant respectfully submits that new claim 33 is also in condition for allowance.

III) Claim Amendments

Applicant has amended claims 1, 6, 8-9, 11, 15-19, and 22-27 by this response.

As discussed previously, Applicant has amended independent claims 1, 11, 19, 22, and 25 to clarify the claimed invention.

Claim 1 was amended to include the limitations of dependent claim 5 and clarify that the identification tag is a radio frequency identification tag. Claim 1 was further amended to clarify that the guest data object and information related to monetary credits are stored in a central server.

Claim 11 was amended to clarify that the identification tag is a radio frequency identification tag and the reader is a radio frequency identification reader. Claim 11 was further amended to clarify that the processor couples the elements together.

Claim 19 was amended to clarify that the identification tag is a radio frequency identification tag and that a plurality of guest data objects are stored within the non-volatile memory and

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associated with a guest within a coverage area. Claim 19 was further amended to clarify that the processor couples the elements together. Claim 19 was further amended to correct a typographical error by changing "of" to --or-- and by deleting an instance of the word "and".

Claims 22 and 25 were amended to clarify that the tag is a radio frequency identification tag and further that the guest data objects and the data structure are stored in a centralized memory of a server.

Claim 6 was amended to change its dependency to independent claim 1 because claim 5 was cancelled.

Claims 1 and 8 were also amended by changing "a" to --said-- to indicate another instance of a phrase or element in the claim.

Claims 8-9, 15-18, 23-24, and 26-27 were also amended to correct punctuation therein.

These amendments to these claims were made for reasons unrelated to patentability.

IV) Specification Amendments

Applicant has amended Paragraph No. 42 on page 11 of the specification to correct the incorrect phrase "guest data object 900" to the proper phrase --group data object 900-- so its consistent with the usage elsewhere in the specification and the figures. A grammatical error has also been corrected therein.

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CONCLUSION

In view of the foregoing it is respectfully submitted that the pending claims are in condition for allowance.

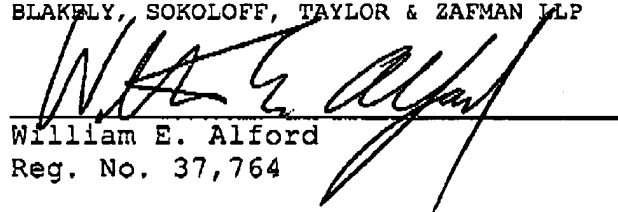
Reconsideration of the rejections and objections is requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant's undersigned counsel by telephone at (714) 557-3800 to expedite the prosecution of this case should there be any unresolved matters remaining.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such deposit account.

Respectfully submitted,
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Dated: March 24, 2004


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I hereby certify that this correspondence is being transmitted via facsimile to the Commissioner for Patents 703-872-9306 on: March 24, 2004.


Wendi Rostan
3/24/04
Date